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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,158	12/11/2000	Hidehiko Ogawa	MAT-8047US	4218

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EXAMINER

NALVEN, ANDREW L

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/734,158	<b>Applicant(s)</b> OGAWA, HIDEHIKO	
	<b>Examiner</b> Andrew L. Nalven	<b>Art Unit</b> 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-3, 6, 8, and 12-14 are pending.
2. Amendment submitted 9 September 2004 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 9/9/04 have been fully considered but they are not persuasive.
4. Applicant has argued on page 5 that the cited prior art fails to teach the placing of "the extracted piece of the sender information in the header of the electronic mail". Examiner respectfully disagrees. Eguchi teaches putting the extracted piece of the sender information in the header of the electronic mail (Eguchi, column 7 line 65 – column 8 line 18, user enters code number, column 6 lines 52-64, header including sender appended when the email is sent) by teaching the adding of the sender name to a header when a mail message is sent. A mail message is only sent with a valid user code is entered. Thus, Eguchi teaches the placing of the extracted information in the header in response to the matching of unique information to stored information.

### ***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 3, 8, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Eguchi US Patent No 6,574,670. Eguchi discloses an electronic mail capable communications device.

7. With regards to claims 1, 12 and 14, Eguchi teaches a first memory for storing sender information of a plurality of users (Eguchi, column 7 lines 40-52, user IDs and passwords), the sender information including unique information corresponding thereto (Eguchi, column 7 lines 40-47, user IDs and passwords), a transmitter for transmitting an electronic mail to a destination terminal via a network (Eguchi, column 8 lines 19-24), the electronic mail including a header and a file which is attached to the electronic mail (Eguchi, column 6 lines 52-64), a controller operable to compare information input to the controller with the unique information, and if the input information matches a piece of the unique information corresponding to one of the users, extract a piece of the sender information corresponding to the one of the users and put the extracted piece of the sender information in the header of the electronic mail (Eguchi, column 7 line 65 – column 8 line 18, user enters code number, column 6 lines 52-64, header including sender appended when the email is sent).

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8. With regards to claim 3, Eguchi teaches sender information including a mail address wherein the mail address is displayed in a sender's column in a mail header of the electronic mail message (Eguchi, column 6 lines 52-64).
9. With regards to claim 8, Eguchi teaches a scanner for scanning a manuscript and converting the manuscript into image data (Eguchi, column 5 lines 33-36) used as the file attached to the electronic mail (Eguchi, column 8 lines 1-18, mime attached to email).
10. With regards to claim 13, Examiner takes official notice that it is well known in the art to see sender information without opening an attached file. When receiving an email, a user is always able to see the sender of the email in a list of received emails. A user may open an attached email after seeing the email in the list of received emails thus the user would see the sender information before opening the attachment.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi US Patent No 6,574,670 in view of Miller et al US Patent No 6,615,241. Miller discloses a correspondent-centric email management system.

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13. With regards to claim 2, Eguchi fails to teach the sender information including the sender's name. Miller teaches the sender's name included in send information and the sender's name displayed in a sender's column in the mail header of the electronic mail message (Miller, column 15 lines 20-33, Figures 5 and 6A). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Miller's method of including the name of the sender with Eguchi's email communications because it offers the recipient of the email the advantage of screening the email according to the sender of the email thus allowing the recipient the ability to eliminate all unwanted/unsolicited emails (Miller, column 4 lines 25-67, column 5 lines 14-31).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eguchi US Patent No 6,574,670 in view of Firth et al US Patent No 5,987,517. Firth discloses a system having a library of protocol independent reentrant network interface functions for providing common calling interfaces for communication and application protocols.

15. With regards to claims 6, Eguchi fails to teach the storage of default sender information and the transmitting of the default information if a password is not input. Firth teaches teach the storage of default sender information and the transmitting of the default information if a password is not input (Firth, column 17 lines 17-44). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Firth's method of sending default information with Eguchi's email communications because it offers the advantage of ensuring that an application program can provide all of the necessary functionality for a user by managing all details

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of the Internet application protocols including filling data structures and handling bad or incomplete data (Firth, column 1 line 66 – column 2 line 6).

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 571 272

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3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571 272 3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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